

## REMARKS

### I. Introduction

Claims **1-3** and **9-29** are currently pending in the present application. Claims **1, 13, 17, 23,** and **27-29** are independent. All pending claims stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 6,115,649 (hereinafter "Sakata") in view of WO 99/09499 (hereinafter "Smith"), in further view of U.S. Patent No. 5,687,322 (hereinafter "Deaton"), in further view of U.S. Patent No. 5,953,055 (hereinafter "Huang").

Upon entry of this amendment, which is respectfully requested, claims **13, 15, 23-24,** and **27** will be amended to more distinctly point out some embodiments and/or to correct apparent errors, and new claims **30-60** will be added. No new matter is believed to be introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.112.

### II. Vague Rejections / Ambiguous Office Action

Applicants respectfully note that the format and/or content of the Non-final Office Action mailed on August 17, 2005 as Part of Paper No./Mail Date 20050804 (hereinafter the "Office Action") is uninformative to the extent that Applicants' ability to recognize and counter the grounds for rejection is substantially hindered. Applicants note, for example, that many claim limitations do not appear to be directly addressed in the rejections as set forth. Nowhere, for example, does the Examiner argue that the generally recited limitation of *outputting a vending machine coupon to a customer based on an identified state of a service queue at a retail establishment* is taught or suggested. Instead, the Examiner sets forth numerous alleged teachings of the cited references, none of which appear to read on the above-cited limitation, and then simply states that all claimed limitations would be "obvious".

Further, the Examiner appears to have modified the current rejections based on copied and pasted text from the previous rejections, without making alterations to reflect

any claim amendments entered by the Examiner pursuant to Applicants' Amendment and Response mailed on March 24, 2005. Applicants note, for example, that the Examiner states claims **1-28** are pending and claims **1-28** are rejected. Applicants point out, however, that claims **4-8** were cancelled by the previous amendment. Accordingly, the Examiner's explicit rejections of claims **4-8** are inappropriate. Further, the Examiner does not explicitly address the amendments made to the other pending claims.

The Office Action generally lacks information anywhere in the record that permits Applicants to guess: (i) whether Applicants previous Amendment and Response was indeed entered, (ii) the substance or basis for the Examiner's interpretation of the claims and/or claim terms, (iii) whether the Examiner has inadvertently ignored certain claim limitations, and/or (iii) what portions of which (if any) of the cited references the Examiner believes explicitly disclose what portions of the claims. Applicants respectfully note that 35 U.S.C. §132 "is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection. See, e.g., *In re Wilke*, 50 C.C.P.A. 964, 314 F.2d 558, 562, 136 USPQ 435, 439 (1963)." *Chester v. Miller*, 906 F.2d 1574 (Fed. Cir. 1990).

Accordingly, as the Office Action fails to allow Applicants to effectively counter the outstanding rejections as set forth, in contravention of 35 U.S.C. §132, Applicants respectfully request that a new Non-final Office Action clarifying the current rejections, properly reflecting the status of all claims, and properly addressing all claim limitations (as amended), be provided.

### **III. The Examiner's Rejections**

Despite the vagueness of the outstanding rejections, Applicants address various deficiencies of the cited references herein. While the following remarks may not necessarily address the Examiner's arguments and/or positions (due to the ambiguities associated therewith), the remarks nonetheless show how no pending claim is rendered obvious by the currently cited references. Accordingly, Applicants respectfully traverse the Examiner's rejections as follows.

### A. Mischaracterizations of Cited References

Initially, Applicants note that the Examiner has mischaracterized various teachings of the cited references. The Examiner states, for example, that Sakata teaches “determining whether the requested transaction can be performed by the vending machine (col 1, lines 54-64)” (Office Action, pg. 3, lines 6-7) and “discloses monitoring when a product is out of stock (col 1, lines 54-64)” (Office Action, pg. 5, line 15). Applicants respectfully note that the Examiner has failed to consider a limitation of the pending claims with respect to the Examiner’s characterization of Sakata. While a **consumer** in Sakata is described as noticing that an item is out of stock, for example, nowhere in the cited portion of Sakata does Sakata contemplate **the vending machine itself** making such a determination. Applicants respectfully note that, at least with respect to claims 13-16, as amended, the pending claims recite the vending machine itself determining that the transaction cannot be performed. Accordingly, as properly interpreted and applied, Sakata fails to teach or suggest such a limitation.

The Examiner further states “**if it is determined that the requested transaction cannot be performed** by the vending machine (col 1, line 54-64), outputting an offer to the customer in response to the received request (col 10, lines 10-22; col 10, lines 4-11).” Office Action, pg. 3, lines 8-10; emphasis added. This is a gross mischaracterization of Sakata. Not only does the information described as being output at Col. 10 of Sakata not constitute an “offer”, there is absolutely no indication in Sakata that such information is outputted **based on the fact** that a transaction is determined to be un-performable by the vending machine. Indeed, Col. 10 describes what happens when a customer selects a product that is available – the opposite of the claimed situation. Accordingly, as properly interpreted and applied, Sakata fails to teach or suggest such a limitation as claimed.

The Examiner further states that Sakata “further discloses the utilization of a trigger signal (Fig. 3a; Fig. 11; Fig. 12).” Office Action, pg. 3, line 11. Applicants have reviewed the cited figures of Sakata and have been unable to identify the alleged “trigger signal” posited by the Examiner. While some figures of Sakata certainly show communications between devices, which is generally well known, nowhere in the cited portions of Sakata does Sakata contemplate a trigger signal being sent from a retail

establishment to a vending machine. Accordingly, as properly interpreted and applied, Sakata fails to teach or suggest such a limitation as claimed.

The Examiner further states that “Sakata’s Manufacturer/Distributor is functionally equivalent to a Retailer and that the Host Computer can obviously be located at the Manufacturer/Distributor (Fig. 12).” Office Action, pg. 3, lines 12-13. Applicants respectfully note that the term “retail establishment” in the pending claims must be afforded meaning (e.g., as defined in Applicants’ specification as filed). If the pending claims simply read “an establishment”, perhaps the Examiner’s characterization of equivalency would hold merit. In the present case, however, the Examiner has simply read the term “retail establishment” out of the claims. Accordingly, as properly interpreted and applied, Sakata fails to teach or suggest such a limitation as claimed.

The Examiner further states that Smith teaches “presenting coupons to the users based on the conditions at the service points (Abstract; Fig. 1,2,4,6, 7; page 3, line 17- page 4, line 15; page 7, lines 17-25).” Applicants have reviewed the cited portions of Smith and have been unable to identify the alleged teaching of presenting coupons to users based on conditions at the service points. While the cited portion of Smith does describe storing information related to service points, Smith does not appear to contemplate presenting coupons based on such information. Accordingly, as properly interpreted and applied, Sakata fails to teach or suggest such a limitation as claimed.

**B. The cited references fail to teach or suggest: *outputting a vending machine coupon to a customer based on an identified state of a service queue at a retail establishment* (claims 1-3 and 9-27)**

Applicants respectfully assert that none of Sakata, Smith, Deaton, nor Huang, alone or in combination, teaches or suggests limitations of claims 1-3 and 9-27. For example, Sakata, Smith, Deaton, and Huang fail to teach or suggest *outputting a vending machine coupon to a customer based on an identified state of a service queue at a retail establishment*.

Applicants respectfully note that no single reference or possible combination of cited references fairly teaches or suggest *outputting a vending machine coupon to a customer based on an identified state of a service queue at a retail establishment*.

None of the cited references even contemplates, for example, conditionally outputting a vending machine coupon based on a state at a retail establishment. Nor is such a limitation obvious. The Examiner makes several statements imputing that such a limitation would be obvious because customers don't like long lines, and it is good to keep customers satisfied, and it is good to promote sales at vending machines. Applicants respectfully note that the Examiner statements appear to reveal confusion by the Examiner with respect to the pending claims.

While the Examiner appears to argue that the presently claimed embodiments shorten lines and promote sales at vending machines, for example, Applicants respectfully note that many embodiments are, to the contrary, directed to promoting sales at retail establishments, such as in the case that lines are short. In other words, some embodiments contemplate directing customer traffic to retail establishments when such establishments need such traffic – as opposed to when such establishments are already packed. As stated, therefore, the Examiner's reasoning does not make sense with respect to the pending claims.

Accordingly, at least because Sakata, Smith, Deaton, and Huang fail to teach or suggest *outputting a vending machine coupon to a customer based on an identified state of a service queue at a retail establishment*, Sakata, Smith, Deaton, and Huang fail to render obvious claims **1-3** and **9-27**. Applicants therefore respectfully request that the §103(a) rejections of claims **1-3** and **9-27** be withdrawn.

### **C. No *Prima Facie* Case of Obviousness**

It is well settled that the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Fritch*, 23 U.S.P.Q.2D 1780, 972 F.2d 1260, 1265 (Fed. Cir. 1992). To reject claims in an application under Section 103, an examiner must show an un-rebutted *prima facie* case of obviousness. *In re Rouffet*, 47 U.S.P.Q.2D 1453, 149 F.3d 1350, 1355 (Fed. Cir. 1998). If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 24 U.S.P.Q.2D 1443, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 5 U.S.P.Q.2d 1596, 837 F.2d 1071 (Fed. Cir. 1988); In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). Prior knowledge in the field of the invention must be supported by tangible teachings of reference materials, and the suggestion to combine references must not be derived by hindsight from knowledge of the invention itself. Cardiac Pacemakers v. St. Jude Medical 381 F.3d 1371, 1376 (Fed. Cir. 2004). Furthermore, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. In re Kotzab, 55 U.S.P.Q.2D 1313, 217 F.3d 1365, 1371 (Fed. Cir. 2000).

A finding of obviousness requires that the art contain something to suggest the desirability of the proposed combination. In re Grabiak, 226 U.S.P.Q. 870, 769 F.2d 729, 732 (Fed. Cir. 1985). In the absence of such a showing, there is inadequate support for the position that the proposed modification would *prima facie* have been obvious. *Id.* The absence of such a suggestion to combine is dispositive in an obviousness determination. Gambro Lundia AB v. Baxter Healthcare Corp., 42 U.S.P.Q.2D 1378, 110 F.3d 1573, 1579 (Fed. Cir. 1997).

In the present case, as described in Section III.B, herein, the Examiner appears to misconstrue the purpose and/or effect of the pending claims. It is not clear, for example, how the alleged motivations of ‘shortening lines’, ‘enticing customers to make purchases at vending machines’, and/or ‘promoting customer conversion to regular customers’ has anything to do with the pending claims, much less how such “motivations” could indeed have motivated one skilled in the art at the time of invention to combine the references as proposed by the Examiner. Further, even if such “motivations” were properly applicable to the pending claims, these “motivations” constitute nothing more than unsupported conclusory statements; not evidence on the record – Applicants respectfully note that the Examiner’s statements do not constitute evidence.

Accordingly, at least because the Examiner has failed to establish a *prima facie* case for obviousness, Applicants respectfully request that this §103(a) ground for rejection be withdrawn.

#### **IV. New Claims**

New claims **30-60** are believed to be patentable over the cited references at least as described herein. Further, after reviewing the cited references, Applicants believe that none of the cited references, alone or in combination, teach, suggest, or render obvious at least:

(i) *determining, by the vending machine, that the qualification condition is satisfied at least in part based on a state associated with a retail establishment (claims **30-53**);*

(ii) *wherein the qualifying condition comprises a condition based on hours of operation associated with the retail establishment (claims **34-36**);*

(iii) *wherein the qualifying condition comprises a condition that the retail establishment be open for business (claim **35**);*

(iv) *wherein the qualifying condition comprises a condition that the retail establishment be open for business for at least a minimum amount of time after a current time (claim **36**);*

(v) *wherein the qualifying condition comprises a condition that less than a threshold number of people be currently awaiting service at the retail establishment (claim **37**);*

(vi) *wherein the qualifying condition comprises a condition that the retail establishment be experiencing less than a threshold rate of transactions (claim **38**);*

(vii) *wherein the qualification condition is further satisfied at least in part based on a state associated with the vending machine (claims **41-44**);*

(viii) *wherein the qualifying condition comprises a condition that a product associated with the transaction be currently out of stock at the vending machine (claims **42-44**);*

(ix) wherein the qualifying condition comprises a condition that the vending machine currently have a low inventory of a product associated with the transaction (claim 45);

(x) wherein the qualifying condition comprises a condition that the vending machine currently be low on change (claim 46);

(xi) wherein the qualifying condition comprises a condition that the vending machine currently be out of change (claim 47);

(xii) wherein the qualifying condition comprises a condition based at least in part on traffic (claim 48); or

(xiii) wherein the qualifying condition comprises a condition based at least in part on weather (claim 49).

(xiv) wherein the qualifying condition comprises a condition based at least in part on a number of offers that have been recently been output to other customers (claim 50);

(xv) wherein the outputting comprises transmitting an indication of the offer to a device associated with the customer (claims 51-53); or

(xvi) wherein the customer device comprises a mobile terminal (claims 52-53).

(xviii) wherein the mobile terminal comprises one or more of a cellular telephone and a Personal Digital Assistant (PDA) (claim 53);

(xviii) a vending machine operable to determine that the qualification condition is satisfied at least in part based on a state associated with the retail establishment (claims 54-60); or

(xix) a camera operable to capture images associated with the number of people waiting for service at the retail establishment, the camera being in communication with the sensor (claims 59-60); or

(xx) wherein the sensor comprises a digital image analysis device (claim 60).



**V. Conclusion**

At least for the foregoing reasons, it is submitted that all pending claims are now in condition for allowance, or in better form for appeal, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via electronic mail at [cfincham@walkerdigital.com](mailto:cfincham@walkerdigital.com), at the Examiner's convenience.

**VI. Petition for Extension of Time to Respond**

While no fees are believed to be due at this time, please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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